

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated July 8, 2005. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-18 are pending in this application. Claim 7 is amended herein to be in independent form. Accordingly, Claims 1, 6, 7, 10, 14, 17, and 18 are independent claims.

In the Office Action, Claims 7-9 and 11-13 are indicated as allowable if amended to be in independent form. It is respectfully submitted that Claim 7 is amended herein to be in independent form and accordingly is allowable. An indication to that effect is respectfully requested. Claims 8, 9, and 11-13 depend from Claim 7 and are allowable for at least that reason as well as for the separately patentable elements contained in each of the claims. An indication as to the allowance of Claims 8, 9, 11-13 is respectfully requested.

Claims 1-4, 10 and 14-16 are rejected under 35 U.S.C. §103 as being obvious over Blandford, U.S. Patent No. 6,470,449 in view of Metcalfe, U.S. Patent Publication No. 2001/2027446. Claim 5 is rejected under 35 U.S.C. §103 as being obvious over Blandford and Metcalfe in view of Hayes-Roth, U.S. Patent Publication No. 2002/0005865. Claim 6 is rejected under 35 U.S.C. §103 as being

obvious over Blandford and Metcalfe in view of Berenson et al., U.S. Patent Publication No. 2001/0049617. Claims 17 and 18 are rejected under 35 U.S.C. §103 as being obvious over Blandford in view of Hayes-Roth.

In response to the above rejections, the following general remarks are presented as applicable for each of the rejections indicated above.

It is respectfully submitted that for each of the above rejection, the Office Action cites a motivation to make combinations of references that finds no support in any of the numerous cited references.

With regard to the rejection of Claims 1-4, 10 and 14-16 under 35 U.S.C. §103 as being obvious over Blandford in view of Metcalfe, the Office Action states that (emphasis provided) "[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Blandford by the teaching of Metcalfe, because including classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto; and the event being unrelated to a calendar/diary application, would enable the system to incorporate multimedia entries to the user's records, and prompting a user, by a calendar/diary application, to enter data relating to the event for incorporation in a historical record of

events pertaining to a user, would enable the user to enter information where the system would maintain the information in a user's historical log." Yet where is this desirability suggested from either of Blandford or Metcalfe.

With regard to the rejection of Claim 5 under 35 U.S.C. §103 as being obvious over Blandford and Metcalfe in view of Hayes-Roth, the Office Action states (emphasis provided) "[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Blandford by the teaching of Hayes-Roth, because having the event including a change in the mood of the user would enable the system to take into consideration the user's state-of-mind (mood) ..." is not contested but is not a motivation to add this feature. Where is the suggestion in the references themselves or a proper motivation why one skilled in the art would be so motivated?

With regard to the rejection of Claim 6 as obvious over Blandford and Metcalfe in view of Berenson, the Office Action states (emphasis provided) "[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Blandford by the teaching of Metcalfe, because including prompting a user for greater detail in an event defined by a record, would enable the user to enter additional information relating to the diary record, in order to complete

and/or gather historical information regarding a diary record." In fact, the same type of conclusory statements are utilized to justify the combination over Blandford in view of Hayes-Roth ("would enable the system to incorporate", see, the Office Action, page 11, second full paragraph) in the rejection of Claims 17 and 18.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also In *re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In *re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." In *re Lee*, 277 F.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." *Id.* "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In *re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614,

1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Office Action that the combinations of prior art references "would be obvious to one having ordinary skill in the art ... " is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. (See, In re Rouffet, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, In re Rouffet, 1458).

The U.S. Court of Appeals for the Federal Circuit (the

"Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) in the *In re Rouffet*, holding. The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with

each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Blandford with the other prior art, could only have been made with hindsight based on the teachings of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-

Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants again respectfully submit that the Examiner has used impermissible hindsight to reject claims 1-15 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Office Action espouse that this reconstruction forwarded does not include knowledge gleamed only from the applicant's disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art. Even the Office Action does not point to any portions of the prior art for teaching the suggestion reconstructions/modification as pointed out above.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997)). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the

mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)).

The applicants respectfully maintain that there is no suggestions in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the applicants' claimed invention.

The Examiner is requested to consider MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS ... The mere fact that references

can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.)"

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of Claims 1-6, 10, and 14-18 finds proper motivation for combination. Further, since the Office Action acknowledges that the prior art alone does not show the claimed features, it is respectfully requested that Claims 1-6, 10, and 14-18 be allowed and an indication to that effect is respectfully requested.

With regard to the response to Arguments section of the Office Action (see, Office Action, page 13-15), each of the arguments presented ignores elements that are required by each of the currently pending claims.

The Office Action states that "Metcalfe teaches the step of 'prompting a user' ... Yet, Claims 1-4, 10, and 14-16 can not be so broadly construed.

Metcalfe merely shows a single application as an electronic activity and business system regulator that includes a standard user interface that requires all information presented in the system to be formatted in a standard manner (see, Metcalfe, FIG. 3A). After the information is received by the application (see, Metcalfe, Block 335) a secondary interface is presented that prompts the user for certain types of user input (see, Metcalfe, FIG. 3B).

Blandford in view of Metcalfe does not disclose or suggest (emphasis provided) "[a] method of generating a diary record, comprising the steps of: classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto; said event being unrelated to a calendar/diary application; prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user; accepting user input responsive to said step of prompting; adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting" as required by Claim 1; nor "wherein said event includes

writing an email letter" as required by Claim 3; nor "wherein said event includes writing a letter on a text application other than said calendar/diary application" as required by Claim 4; nor "[a] method of generating a diary record, comprising the steps of: detecting one of a passage of time since an entry of a record into a diary database and a time of day; prompting a user to enter a diary entry responsively to said step of detecting; accepting data to form a new record in a diary; adding a new record responsive to a result of said step of accepting" as required by Claim 10 (Blandford merely "ensures that data is never time-stamped with a date different from that of the current clock, nor with a time earlier than the most recent previous time a record was stored in the diary", see, Blandford, Col. 3, lines 7-11, and Metcalfe merely "prompts the user to enter information relative to the time or times when the transaction is performed", see, Metcalfe, paragraph 39), nor "[a] method of generating a diary record, comprising the steps of: extracting current events or historical data from an external data resource; accepting data descriptive of an appointment and an event of the current events for inclusion in a diary database; adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database" as required by Claim 14 (the cited sections of Blandford merely state that a user may import or export to an

external text or data file and that a search may be conducted using parameters such as a date or date range, see, Blandford, Col. 4, lines 65-67 and Col. 14, lines 49-60 and Metcalfe in the cited sections merely describes the primary and secondary interface as described above and that information gathered by the system may be utilized to simplify the creation of features such as a diary or address book, see, Metcalfe, paragraphs 39-40 and 55).

Hayes-Roth discloses a method and device for authoring content of a computer-controlled agent; in which the structure of prospective interactions between agents and their users is anticipated. Hayes-Roth does not cure the above-cited deficiencies of Blandford and Metcalfe as they relate to independent claim 1. Further, Blandford in view of Hayes-Roth does not disclose or suggest "wherein said event includes a change in a mood of said user" as required by Claim 5. Accordingly, separate consideration and allowance of Claim 5 is respectfully requested.

Independent claim 6 requires "[a] method of generating a diary record, comprising the steps of: accepting data towards the making of a new record in a calendar application; prompting a user for greater detail in an event defined by said record other than a time of occurrence; automatically generating a diary record responsive to a result of said steps of accepting and prompting."

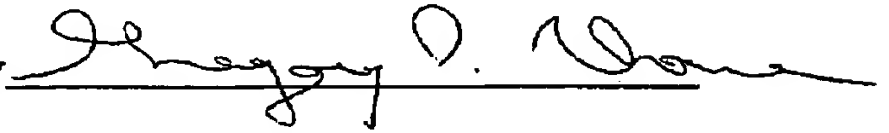
Blandford in view of Metcalfe in further view of Berenson does not disclose or suggest the elements as claimed in independent claim 6. Accordingly, it is respectfully requested that this rejection be withdrawn.

Lastly, Blandford in view of Hayes-Roth does not disclose or suggest "[a] method of generating a diary record, comprising the steps of: accepting user input data descriptive of personal events to be recorded in a diary database; sensing and classifying states, events, or moods of a user or said user's environment; generating an index responsive to said step of sensing; adding said index and said user input to said diary database" as required by Claim 17 and as essentially required by Claim 18. Regardless of what is asserted in the Office Action, sensing a mood of a user is not sufficient to satisfy the limitations of Claims 17 and 18 and an indication to that effect is respectfully requested.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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Enclosure: Authorization to charge credit card \$200 for one claim in excess of six already paid (seven total)

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